

## REMARKS

In the application claims 54-80 remain pending. No new claims have been added and no further claims have been canceled. The reconsideration of the rejection of the claims is respectfully requested.

In the latest Office Action, the pending claims were rejected based upon the combination of Kemink (WO 0017738) and Hayes (US Patent No. 6,223,348). In response to this rejection, it is respectfully submitted that a *prima facie* case of obviousness under 35 U.S.C. § 103 requires that the combination of prior art references disclose each and every element set forth in the claims, considering each and every word. This requirement that the claimed invention be considered “as a whole” is meant to prevent evaluation of an invention part by part, i.e., breaking an invention into its component parts and then merely finding a reference containing one part, another reference containing another part, etc., and to prevent the impermissible use of the specification of the applicant as a template to combine these parts for the purpose of deprecating the claimed invention. Thus, to assure that such “hindsight reasoning” is not used when assessing the patentability of a claimed invention, a rejection under 35 U.S.C. § 103 requires a demonstration that an artisan of ordinary skill in the art at the time of the invention, with no knowledge of the claimed invention, would have selected the various parts from the references and combined them in the claimed manner.

The claimed invention is directed to a method of configuring a remote control to command functions of a consumer electronic device. To this end, the claimed method includes, among other things, receiving input that identifies a type and brand of consumer electronic device, using the input that identifies the type and brand of consumer electronic device to select a plurality of function code sets that have been identified as being candidates for commanding

operations of the specified type and brand of consumer electronic device, and causing the plurality of function code sets to be downloaded into a remote control whereby a user may determine by experimentation which of the plurality of function code sets is appropriate for commanding operations of the consumer electronic device that is actually owned by the user. As described in the subject application, at page 17, lines 16-23, *this method for configuring a remote control solves, among others, the problem of how to configure a remote control when the user does not have his model number available or when a model number provided is not recognized by the configuring system.*

In contrast to the claimed invention, the system and method described in Kemink requires a user to know the model number of a consumer electronic device in order to configure the remote control. In this regard, Kemink describes that the remote control is configured immediately after the downloading has occurred and what is downloaded is the single function code set which the configuring system of Kemink identifies, as a function of the specified model number, as being appropriate for commanding the consumer electronic device.

More particularly, the configuring system of Kemink uses a consumer electronic device specific profile to determine the single function code set that is to be downloaded into the remote control to configure the remote control to command that consumer electronic device. (Page 6, lines 7-10). The consumer electronic device specific profile is created by a user being “led through a sequence of links and web pages until a manufacturer’s model number is found that corresponds, for example, to the television 251 in FIG. 2.” (See Page 6, lines 13-15). While the user may also be presented with a plurality of graphical user interfaces, i.e., nothing more than “selectable buttons, icons, clusters of icons, templates, and the like” (See Page 4, lines 31-33) which are actuated to cause select function codes from a function code set to be transmitted to an

intended target consumer electronic device, one of which is downloadable for use in the remote control (*See* Page 6, lines 15-17, Page 7, lines 18-22), the fact remains that only a single function code set, i.e., the single function code set which the configuring system of Kemink determines to be appropriate for the particular consumer electronic device model number specified by the user, is downloaded into the remote control.

Therefore, Kemink, which requires the use of a manufacturer's model number to cause a single function code set to be downloaded into a remote control, suffers the very disadvantage the subject invention seeks to overcome.

From the foregoing, it is submitted that the configuring system of Kemink, which uses input that specifies a manufacturer's model number to cause a single function code set to be downloaded into a remote control, cannot be said to disclose, teach, or suggest the claimed using *a type and brand* of a consumer electronic device to cause a *plurality of function code sets* identified as being appropriate for commanding functions of the specified type and brand of consumer electronic device to be downloaded into a remote control after which a user [not the configuring system as in Kemink] determines which of the downloaded *plurality of function codes sets* is appropriate for commanding the consumer electronic device actually owned by the user. (*See* claims 54 and 71)

It is additionally submitted that the reason that Kemink does not disclose, teach, or suggest that a user may interact with the remote control to determine by experimentation which of a plurality of function code sets is appropriate for commanding operations of a consumer electronic device (as has been acknowledged in the Office Action) is for the reason that, since the user is required to know in advance the model number of their consumer electronic device and since the configuring system of Kemink uses the model number to select a single function

code set which is downloaded into the remote control, the remote control of Kemink will be configured to command operations of the consumer electronic device immediately after the downloading of the single function code set occurs. As such, it is evident that the system of Kemink, which provides a configured remote control upon conclusion of the step of downloading [provided the user knows and the system recognizes the model number], renders the performing of further experimentation by the user superfluous. Simply stated, *given the express requirements and results of the Kemink system there would be no reason and no motivation to modify Kemink to allow for the claimed downloading of plural command codes sets and selection via user experimentation.*

While Hayes, which is commonly assigned to Universal Electronics Inc, discloses that “the user is able to experiment with various device codes until he finds the one which will operate his electronic device” (Col. 4, lines 34-36), Hayes does not disclose, teach, or suggest those claim elements missing from Kemink. More particularly, like Kemink, Hayes does not suggest the desirability of allowing a user to specify *a type and brand* of a consumer electronic device to cause a *plurality of function code sets* identified as being appropriate for commanding functions of the specified type and brand of consumer electronic device *to be downloaded into a remote control*. Accordingly, since Hayes fails to disclose, teach, or suggest these claim elements, it is respectfully submitted that the rejection of the claims must be withdrawn for failure to make a *prima facie* case of obviousness.

In sum, for the reason that Kemink fails to disclose a system in which a user specifies *a type and brand* of a consumer electronic device to cause a *plurality of function code sets* identified as being appropriate for commanding functions of the specified type and brand of consumer electronic device *to be downloaded into a remote control*, and Hayes fails to suggest

the desirability of modifying Kemink to include the same, it is submitted that the rejection of the claims should be withdrawn.

CONCLUSION

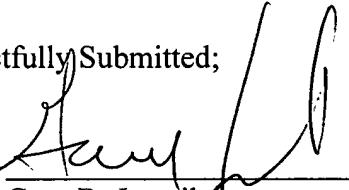
It is respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Examiner is respectfully requested. Should it be determined, however, that a telephone conference would expedite the prosecution of the subject application, the Examiner is respectfully requested to contact the attorney undersigned.

The Commissioner is authorized to charge any fee deficiency or credit overpayment to deposit account 50-2428 in the name of Greenberg Traurig.

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Respectfully Submitted;

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